

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Mike Sage

Application No.: 09/736,649

Filed: December 13, 2000

For: SYSTEM AND METHOD FOR
IMPLEMENTING A WIRELESS
NETWORK IN A SERVICE CENTER
FOR GENERATING A REPAIR
ORDER

Examiner: Gerald J. O'Connor

Group Art Unit: 3627

Confirmation No. 8281

March 12, 2008

Costa Mesa, California 92626

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

Mail Stop APPEAL BRIEF – PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

This Reply Brief is filed pursuant to 37 C.F.R. § 41.41, in response to the Examiner's Answer mailed January 15, 2008. Appellant's Notice of Appeal was filed on June 11, 2007. The fee required under 37 CFR §41.20(b)(2) was previously submitted.

STATUS OF CLAIMS

Claims 1, 4-5, 7-9, 13, 32-33 and 37-43 are pending in the application.

Claims 1, 4-5, 7-9, 13, 32-33 and 37-43 stand rejected under 35 U.S.C. §103(a). The claims stand and fall together.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 4-5, 7-9, 13, 32-33 and 37-43 stand rejected under 35 U.S.C. §103(a) as allegedly obvious over Patent No. 6,609,050 B2 to Li in view of Patent No. 6,370,454 B1 to Moore.

ARGUMENT

The Obviousness Rejection Should be Withdrawn Because the References Fail to Disclose or Suggest Each and Every Element of Claim 1 and Because the Claimed Invention Could Not Have Been Predicted in view of the Art of Record

In its Appeal Brief, Applicant set forth reasons for patentability of the rejected claims. Among others, Applicant argued that: (i) the references failed to disclose or suggest each and every element of the independent claim; and (ii) the claimed invention was not predictable over the references. The Examiner's Answer fails to rebut Applicant's arguments.

First, the Examiner Answer stated that "the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but *need not be in the identical words* as used in the claims in order to be anticipatory." Examiner's Answer, page 5 (emphasis original). Here, the references are not merely using different terminology to describe similar concepts as Applicant's. The references fail to disclose or suggest certain claimed elements entirely. As stated in Applicant's Brief, the references fail to disclose or suggest:

retrieving a dataset associated with the vehicle by querying a database as a function of said vehicle identifier, said data set having a vehicle service history and a service list, said service list having a plurality of service items as a function of a mileage, the vehicle history, recommended maintenance, factory recall, and available service campaigns.

While Li discloses receiving the vehicle's mileage, it does not disclose nor specifically suggests selecting service items "as a function of a mileage, the vehicle history, recommended maintenance, factory recall, and available service campaigns." Under this Board's recent holding, a *prima facie* case of obviousness requires a teaching of *all* of the elements in the claim and not just some of them. See *Ex Parte Karoleen B. Alexander*, Appeal 2007-2693, Tech. Center 3600 (Nov. 30, 2007). In the instant case, the references do

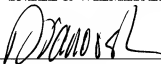
not disclose all of the claimed features. As such, a *prima facie* case of obviousness is lacking and the claims are patentable over the art of record.

Second, the Examiner's Answer that the motivation to combine is readily found in a person of ordinary skill in the art does not rebut Applicant's argument that the claimed improvement is more than the predictable use of the prior art elements. In *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742 (2007), the Supreme Court held that obviousness can be proved "by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claim." Here, neither reference contemplates the problem addressed by Applicant's invention, much less provide a solution thereto. Li is directed to helping the customer diagnose the vehicle's problem before arriving at the dealership. Moore is directed to allowing a remote data center initiate a service appointment. Neither reference contemplates providing a customized service menu to the customer and allowing the customer to select one or more services from the menu. Because the references did not contemplate the problem addressed by Applicant, they could not have predicted the solution invented by Applicant.

For these additional reasons, Applicant respectfully submit that Claim 1 and all other claims depending therefrom, either directly or indirectly, are patentable over the prior art of record. This appeal should be granted in favor of Applicant and claims 1, 4-5, 7-9, 13, 32-33 and 37-43 should be allowed.

Respectfully submitted,

SNELL & WILMER L.L.P.

A handwritten signature in black ink, appearing to read 'Dianoosh Salehi', is written over a horizontal line.

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